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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,123	10/10/2000	Alex M. Gernert	SYM-0606C	7157

28661 7590 11/24/2003

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EXAMINER	
NEURAUTER, GEORGE C	

ART UNIT	PAPER NUMBER
2143	18

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/686,123	Applicant(s) GERNERT ET AL.	
	Examiner George C Neurauter, Jr.	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-29 and 35-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-29 and 35-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 24 October 2003 have been fully considered but they are not persuasive.

In regards to Applicant's argument that Seazholtz does not teach "determining a particular time at which the mobile computer terminal is to send a message to the host computer to avoid being disconnected", "waking up during the programming of the timer or clock", and "sending the message at said particular time" as claimed in claim 27, Seazholtz does in fact disclose these limitations within the references provided in the preceding Office Action mailed 21 August 2003.

Seazholtz expressly discloses:

"Data communication directed to a particular mobile station is often lost if the mobile station does not scan for...data within a predetermined period of time. Thus, if data transmission communications are being held within the network for a mobile station that is temporarily off the data network, such communication is easily lost (usually by being discarded by the network) if the mobile station does not re-establish contact with the data network within a time period determined by the network." (column 3, line 61-column 4, line 3) (emphasis added)

"The mobile end stations are expected to wake up at periodic intervals to determine if data for them is pending, and notify the network that they are willing to receive the pending data." (column 8, lines 45-48) (emphasis added)

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 27 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Seazholtz et al. [US Patent 5 737 706 A].

Regarding claim 27, Seazholtz discloses a method for communication between a mobile computer terminal and a host computer in a system in which it is necessary in order to avoid being disconnected for the mobile computer terminal to send a message to the host computer, including the steps of: determining a particular time at which the mobile computer terminal is to send the message to the host computer; programming a timer or clock to wake up the mobile computer terminal so that the mobile computer terminal can send the message at said particular time; entering the mobile computer into a sleep mode; waking up the mobile computer terminal due to the programming of the timer or clock; and sending the message at said particular time. [column 3, line 53-column 4, line 3; column 8, line 22-column 9, line 51, specifically column 8, lines 22-63 and column 9, lines 37-51]

Claim 37 is also rejected since claim 37 contains substantially the same limitations as recited in claim 27.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 28, 35, 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz et al. in view of Lim et al. [US Patent 5 884 024 A]

Regarding claim 28, Seazholtz discloses the method of claim 27.

Seazholtz does not disclose wherein said system is a system utilizing the limited leasing of IP addresses and said message is a message begging for more time, however, Seazholtz does disclose that the system is substantially similar to other systems that are well known and used in the art that are used for, *inter alia*, assigning addresses to mobile computers or client computers [column 5, line 53-column 6, line 9; column 7, lines 10-33].

Lim discloses that a system that utilizes the limited leasing of IP addresses wherein messages are sent to beg for more time are well known and used in the art in the context of the substantially similar systems as disclosed within Seazholtz [column 1, line 62-column 2, line 14].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to combine the teachings of Seazholtz and Lim since one of ordinary skill in the art would have known and routinely used the well-known subject matter disclosed in Seazholtz and Lim, which is expressly shown in view of the disclosures of Seazholtz and Lim, and combining the disclosures of both references would have involved only routine skill in the art.

Claim 38 is also rejected since claim 38 contains substantially the same limitations as recited in claim 28 and is subject to the same motivations regarding the obviousness of claim 28.

Regarding claim 35, Seazholtz and Lim disclose the method of claim 27.

Seazholtz does not expressly disclose wherein said message is a lease renewal message, however, Lim discloses that this limitation is well known and used in the art in

the context of wireless transmission systems as described in Seazholtz as described above regarding claim 27 [column 2, lines 12-14].

Claim 35 is rejected since the motivations regarding the obviousness of claim 27 also apply to claim 35.

Claim 40 is also rejected since claim 40 contains substantially the same limitations as recited in claim 35 and is subject to the same motivations regarding the obviousness of claim 35.

7. Claims 29, 36, 39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seazholtz et al. and Lim et al. as applied to claims 28 and 38 above, and further in view of Emerson et al. [US Patent 4 775 996 A].

Regarding claim 29, Seazholtz and Lim disclose the method of claim 28.

Seazholtz and Lim do not expressly disclose determining if the mobile computer is out of range of communications with the host computer or displaying a message on the mobile computer indicating to the user that the mobile computer must be brought back into range of communications with the host computer or else said leased IP address may be forfeited, however, Lim also discloses the concept of IP leasing in the context of wireless transmission systems as described above regarding claim 28.

Emerson discloses that the concept of determining if a mobile computer is out of range of communications with a host computer and displaying a message on the mobile computer indicating to a user that the mobile computer must be brought back into range of communications with the host computer is well known and used in the art in the

context of wireless transmission systems [column 1, lines 11-38, specifically lines 29-38].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to display a message on the mobile computer indicating to the user that the mobile computer must be brought back into range of communications with the host computer or else a leased IP address may be forfeited since one of ordinary skill in the art would have known and routinely used the well-known subject matter as disclosed in Emerson. In view of the combined disclosures of Seazholtz and Lim as described in claim 28, combining the methods disclosed in Emerson with using a timer or clock as described in Seazholtz to determine whether the IP address lease is about to expire as described in Lim would have involved only routine skill in the art.

Claim 39 is also rejected since claim 39 contains substantially the same limitations as recited in claim 29 and is subject to the same motivations regarding the obviousness of claim 29.

Regarding claim 36, Seazholtz, Lim, and Emerson disclose the method of claim 29.

Seazholtz, Lim, and Emerson do not disclose the method further including the step of resetting said timer or clock for a next scheduled beg time if the mobile computer is out of range of communications with the host computer, however, Seazholtz does disclose resetting said timer or clock for a next scheduled beg time [column 8, line 64-column 9, line 51] and Emerson discloses determining if the mobile computer is out of

range of communications with a base unit or host computer [column 1, lines 11-38, specifically lines 29-38].

Claim 36 is rejected since the motivations regarding the obviousness of claim 29 also apply to claim 36.

Claim 41 is also rejected since claim 41 contains substantially the same limitations as recited in claim 36 and is subject to the same motivations regarding the obviousness of claim 36.

8. Claims 42 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's admitted prior art [US Patent 5 029 183 A to Tymes] in view of Seazholtz et al.

Regarding claim 42, the Applicant's admitted prior art discloses a mobile computer terminal including: a communications module for communication with a base unit or host computer in a system; a hand-held image scanner; a processor; and a memory having stored therein program instructions for reading by the processor such that the mobile computer terminal performs the steps of: reading an image by said hand-held scanner; transforming data corresponding to the image read, the transformed data to be transferred from the mobile computer terminal for eventual entry into a database; sending the transformed data to a base unit or host computer according to coordinated data formatting and ordering between the mobile terminal and the base unit or host computer [column 2, line 55-column 3, line 57; column 6, lines 28-56; column 11, line 25-column 12, line 8].

The Applicant's admitted prior art does not expressly disclose determining a particular time at which the mobile computer terminal is to send a message to the base unit or host computer to avoid being disconnected; programming a timer or clock to wake up the mobile computer terminal so that the mobile computer terminal can send the message at said particular time; entering the mobile computer terminal into a sleep mode; and waking up the mobile computer terminal from the sleep mode due to the programming of the timer or clock to send the message at the particular time, however, Seazholtz discloses that these limitations are well known and used in the art in the context of wireless transmission systems [column 3, line 53-column 4, line 3; column 8, line 22-column 9, line 51, specifically column 8, lines 22-63 and column 9, lines 37-51].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Applicant's admitted prior art with the disclosures of Seazholtz since one of ordinary skill in the art would have known and routinely used the well known subject matter disclosed in Seazholtz. Since the Applicant admits the mobile computer terminal as known prior art, combining the mobile computer terminal with the disclosures of Seazholtz would have involved only routine skill in the art.

Claim 47 is also rejected since claim 47 substantially contains the same limitations as recited in claim 42 and is subject the same motivations regarding the obviousness of claim 42.

9. Claims 43, 45, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's admitted prior art and Seazholtz et al. as applied to claims 42 and 47 above, and further in view of Lim et al.

Regarding claim 43, the Applicant's admitted prior art and Seazholtz disclose the mobile computer terminal of claim 42.

The Applicant's admitted prior art and Seazholtz do not disclose wherein said system is a system utilizing the limited leasing of IP addresses and said message is a message begging for more time, however, Seazholtz does disclose that the system is substantially similar to other systems that are well known and used in the art that are used for, *inter alia*, assigning addresses to mobile computers or client computers [column 5, line 53-column 6, line 9; column 7, lines 10-33].

Lim discloses that a system that utilizes the limited leasing of IP addresses wherein messages are sent to beg for more time are well known and used in the art in the context of the substantially similar systems as disclosed within Seazholtz [column 1, line 62-column 2, line 14].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to combine the teachings of the Applicant's admitted prior art, Seazholtz, and Lim since one of ordinary skill in the art would have known and routinely used the well-known subject matter disclosed in Seazholtz and Lim, which is expressly shown in view of the disclosures of Seazholtz and Lim. Since the Applicant admits the mobile computer terminal as claimed in claim 42, the combination of these references with the admitted prior art would have involved only routine skill in the art.

Claim 48 is rejected since claim 48 contains substantially the same limitations as recited in claim 43 and is subject to the same motivations regarding the obviousness of claim 43.

Regarding claim 45, the Applicant's admitted prior art and Seazholtz disclose the mobile computer terminal of claim 42.

The Applicant's admitted prior art and Seazholtz do not disclose wherein said message is a lease renewal message, however, Lim discloses that this limitation is well known and used in the art in the context of wireless transmission systems as described in Seazholtz as described above regarding claim 43.

Claim 45 is rejected since the motivations regarding the obviousness of claim 43 also apply to claim 45.

Claim 50 is also rejected since claim 50 contains substantially the same limitations as recited in claim 45 and is subject to the same motivations regarding the obviousness of claim 45.

10. Claims 44, 46, 49, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's admitted prior art, Seazholtz et al, and Lim et al. as applied to claims 43 and 48 above, and further in view of Emerson et al.

Regarding claim 44, the Applicant's admitted prior art, Seazholtz, and Lim disclose the mobile computer terminal of claim 43.

The Applicant's admitted prior art, Seazholtz, and Lim do not expressly disclose wherein the mobile computer terminal comprises the memory having stored therein further program instructions for reading by the processor such that the mobile computer

terminal performs the further steps of: determining if the mobile computer is out of range of communications with the base unit or host computer; and displaying a message on the mobile computer indicating to the user that the mobile computer must be brought back into range of communications with the base unit or host computer or else said leased IP address may be forfeited, however, Lim also discloses the concept of IP leasing in the context of wireless transmission systems as described above regarding claim 43.

Emerson discloses that the concept of determining if a mobile computer is out of range of communications with a host computer and displaying a message on the mobile computer indicating to a user that the mobile computer must be brought back into range of communications with the host computer is well known and used in the art in the context of wireless transmission systems [column 1, lines 11-38, specifically lines 29-38].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to display a message on the mobile computer indicating to the user that the mobile computer must be brought back into range of communications with the host computer or else a leased IP address may be forfeited since one of ordinary skill in the art would have known and routinely used the well-known subject matter as disclosed in Emerson. In view of the combined disclosures of Seazholtz and Lim as described in claim 43, combining the methods disclosed in Emerson with using a timer or clock as described in Seazholtz to determine whether the IP address lease is about to expire as described in Lim would have involved only routine skill in the art. Since the

Applicant admits the mobile computer terminal as claimed in claim 42, the combination of these references with the admitted prior art would have also involved only routine skill in the art.

Claim 49 is also rejected since claim 49 contains substantially the same limitations as recited in claim 44 and is subject to the same motivations regarding the obviousness of claim 44.

Regarding claim 46, the Applicant's admitted prior art, Seazholtz, Lim, and Emerson disclose the mobile computer terminal of claim 44.

The Applicant's admitted prior art, Seazholtz, Lim, and Emerson do not expressly disclose the memory having stored therein further program instructions for reading by the processor such that the mobile computer terminal performs the further step of: resetting said timer or clock for a next scheduled beg time if the mobile computer is out of range of communications with the base unit or host computer, however, Seazholtz does disclose resetting said timer or clock for a next scheduled beg time [column 8, line 64-column 9, line 51] and Emerson discloses determining if the mobile computer is out of range of communications with a base unit or host computer [column 1, lines 11-38, specifically lines 29-38].

Claim 46 is rejected since the motivations regarding the obviousness of claim 44 also apply to clam 46.

Claim 51 is also rejected since claim 51 contains substantially the same limitations as recited in claim 46 and is subject to the same motivations regarding the obviousness of claim 46.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Monday-Saturday 5:30am-10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER

gcn